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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/038,857 | 01/08/2002 | Giovanni Benini | 449122020100 | 6367 |
| 25227 | 7590 | 07/29/2005 | | EXAMINER |
| MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102 | | | TAYLOR, BARRY W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2643 | |

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/038,857 | BENINI ET AL. | |
| | Examiner | Art Unit | |
| | Barry W. Taylor | 2643 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 May 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-14 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1 and 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Examiner is unable to determine from the originally filed specification as to how one of ordinary skill in the art would be able to make and use the invention. The specification provides no basis for the claimed subject matter. Specifically, as by way of example, independent claims 1 and 11-14 now recite a telephone network employing circuit switching wherein the telephone network performs the storing, controlling, transmitting and clearing the data transmissions.

In contrast, the specification and figure clearly discloses data transmission network employing routers (i.e. transfer units 1 and 2---see figure 1A and 1B) using IP protocol. The only place that even mentions "circuit" and/or "telephone" is in Applicant's admitted prior art teaching (see specification page 1, lines 11-13). Applicant's entire disclosure is directed towards packet-switching verses circuit-switching. Applicant's specification page 6 lines 17-19 reveal that classic circuit-switched networks may

be used but never describes how this is done nor provides the basis of how one or ordinary skill in the art could modify the packet-switch network to function as conventional circuit-switch network. Instead, the entire disclosure is directed towards the IP network using SIP protocol and Tokens (see Applicant's entire disclosure and figure 1A-1B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leleu (6,088,687) in view of Corwith (6,259,778). The following rejection is being made for what is best understood by the Examiner due to the 112 first rejection listed above.

Regarding claims 1 and 11-14. Leleu teaches a charge metering method and system for data transmission, comprising a centralized and decentralized network resources (see at least col. 6 lines 14-45 wherein classic switching networks may be used):

storing at least one electronic credit which includes a statement on the amount of use of transmission units of a data transmission network on two terminals operated on the data transmission network (abstract, columns 2-3, see columns 3-4 wherein "nodes" or "routers" used to store electronic credit (i.e. toll token), see col. 7 line 61 – col. 8 line 67 wherein toll token used at any time and at any node (i.e. packet-origination and packet-termination nodes) to authorize an electronic system to perform an operation;

controlling the use of data transmission units of the data network by two control units (see columns 3-4 and 7-8 wherein two nodes used (i.e. origination and termination nodes). Leleu col. 7 lines 37-38 reveal that either calling side control unit or called side control unit may control and col. 9 lines 22-64 reveals that any control unit may be used.

transmitting a credit for use of the data transmission path to an assigned control unit (see figure 2 wherein calling node 200 transmits toll token to be used for datagram sent from calling node 200 to receiving node 201); and

reserving the transmission units of the data transmission network to use the data transmission path based on the credit received (see figure 2 wherein path taken by datagram is the arc 200, 210, 230, 231, 233, 234, 235, 220 and 201 whereby token is inserted into datagram allowing for transmission of data contained in packet to be processed by each node as it travels through network (col. 8 lines 49-67). Leleu col. 7

lines 37-38 reveal that either calling side control unit or called side control unit may control and col. 9 lines 22-64 reveals that any control unit may be used.

According to Applicant's newly amended claims and remarks (see remarks on page 6, paper dated 9/7/2004 and amendments to independent claims; see newly amended claims and remarks on page 6, paper dated 5/24/05), wherein Applicants contend that Leleu fails to teach telephone network.

Corwith teaches a method and apparatus for detecting modem tones for implementation of a different billing structure (Title, abstract). Corwith allows telecommunications company the ability to charge different rate for modem calls than local calls (col. 1 lines 13-64). Corwith uses voice/modem detector (item 24 figure 1) and a bit transfer detector (26 figure 1) enabling telephone company the ability to implement a variety of billing schemes (col. 2 lines 11-17, col. 2 line 38 – col. 4 line 5). Corwith further discloses (col. 2 lines 11-17, col. 3 lines 1-22, col. 3 lines 52-55) routing voice calls to PSTN and modem calls to Internet service provider's Point Of Presence (a.k.a. POP).

Therefore, it would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Leleu to use voice/modem detector and bit transfer detector as taught by Corwith providing for a more flexible system that allows telephone companies the ability to implement a variety of billing schemes for modem calls that are different from local calls.

Regarding claim 2. Leleu teaches sending toll token from one node to another node (see figure 2, col. 3 lines 58-62).

Regarding claim 3. Leleu teaches sending credit is the terminal beginning the data transmission (see figure 2 wherein sending terminal 200 is the terminal beginning data transmission).

Regarding claim 4. Leleu teaches the token is issued with regards with transmission path which is to be set up or has been set up (col. 2 lines 49-57, col. 7 lines 4-67, col. 8 lines 21-27, col. 8 line 26 – col. 17 line 37).

Regarding claim 5. Leleu teaches token includes at least identification of terminal beginning the data transmission (see col. 2 line 52 wherein token at least includes function of the destination address (i.e. identification of other terminal), see col. 4 wherein token includes information relating to the user (i.e. terminal beginning the data transmission), see col. 6 lines 36-40 wherein datagram supports different protocols, Leleu even using an id to identify the creator of the token---see column 9, Leleu even offers tokens of different denominations for different service grades and types of operators which obviously require checking by the nodes)).

Regarding claim 6. Leleu teaches period of validity or a date of validity is fixed (see bottom of column 8) and the period of validity is at least one less than approximately five minutes (see top of column 9 wherein the time period which may not, in general, exceed several seconds which is obviously less than approximately five minutes).

Regarding claims 7-8. Leleu teaches cryptographic method (see cryptography starting on column 11 and continuing to column 15).

Regarding claim 9. Leleu teaches data network operating in accordance with Internet Protocol (col. 6 lines 36-39, col. 15 lines 26-32).

Regarding claim 10. Leleu teaches using telephone service (col. 6 lines 36-40, col. 15 lines 26-32).

Response to Arguments

3. Applicant's arguments filed 5/24/05 have been fully considered but they are not persuasive.

a) Applicants contend that the telephone network performs the storing, controlling, transmitting and clearing the data somewhere in the Applicants specification wherein electronic credit is used to reserve the resources for the data communication at the terminal end.

The Examiner kindly request Applicants to point where this is taught in the specification. The Examiner is unable to determine from the originally filed specification as to how one of ordinary skill in the art would be able to make and use the invention. The specification provides no basis for the claimed subject matter. Specifically, as by way of example, independent claims 1 and 11-14 recite a centralized network and decentralized network wherein a telephone network employing circuit switching wherein the telephone network performs the storing, controlling, transmitting and clearing the data transmissions.

In contrast, the specification and figure clearly discloses data transmission network employing routers (i.e. transfer units 1 and 2---see figure 1A and 1B) using IP protocol. The only place that even mentions "circuit" and/or "telephone" is in Applicant's admitted prior art teaching (see specification page 1, lines 11-13). Applicant's entire disclosure is directed towards packet-switching verses circuit-switching. Applicant's specification page 6 lines 17-19 reveal that classic circuit-switched networks may be used but never describes how this is done nor provides the basis of how one or ordinary skill in the art could modify the packet-switch network to function as conventional circuit-switch network. Instead, the entire disclosure is directed towards the IP network using SIP protocol and Tokens (see Applicant's entire disclosure and figure 1A-1B).

Therefore, Leleu also discloses that classic switching networks may be used (see at least col. 6 lines 14-45 wherein classic switching networks may be used).

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Friday, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached at (571) 272-7499. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Centralized Delivery Policy: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the central fax number (**571-273-8300**).



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